UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/214,971	01/15/1999	GABRIELE VALENTE	30966.13USWO	7959

7590 02/12/2002

OPPENHEIMER WOLFE & DONNELY LLP
2029 CENTURY PARK EAST
38TH FLOOR
LOS ANGELES, CA 90067-3024

EXAMINER
CHEVALIER, ALICIA ANN

ART UNIT	PAPER NUMBER
1772	17

DATE MAILED: 02/12/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/214,971	VALENTE, GABRIELE	
	Examiner	Art Unit	
	Alicia Chevalier	1772	

-- The MAILING DATE of this c mmunication appears on the cover sheet with the correspondence address --

Period f r Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 September 2001* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *5-36* is/are pending in the application.

4a) Of the above claim(s) *5-7,10-12,15-17 and 20-23* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *8,9,13,14,18,19 and 24-36* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

RESPONSE TO AMENDMENT

WITHDRAWN REJECTIONS

1. The 35 U.S.C. §112 rejections of claims 8 and 9 of record in paper #15, page 3, paragraph #8 have been withdrawn due to Applicant's amendment in paper #16.

REJECTIONS REPEATED

2. The 35 U.S.C. §103 rejection of claims 8, 9, 13, 14, 18, and 19 over Schwartz (3,741,844) in view of Taylor (3,971,839) is repeated for reasons of record in paper #15, pages 3-4, paragraph #9.

3. The 35 U.S.C. §103 rejection of claims 8, 9, 13, 14, 18, and 19 over Irion (2,714,571) in view of Holtzman (3,866,554) or Lockwood (3,641,603) is repeated for reasons of record in paper #15, pages 4-5, paragraph #10.

NEW REJECTIONS

4. **The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

Claim Rejections - 35 USC § 112

5. Claims 28 and 29 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "dye stuff" in claim 28 is unclear which renders the claims vague and indefinite. It is unclear from the claim and the specification what is encompassed by the term "stuff." Is the dye stuff layer merely a layer of dye or are there additives mixed with a die, etc.

The term "like" in claim 29 is unclear which renders the claims vague and indefinite. The addition of the word "like" to an otherwise definite expression extends the scope of the expression so as to render it indefinite.

Claim Rejections - 35 USC § 103

6. Claims 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwartz (3,741,844) in view of Taylor (3,971,839) for reasons of record in paper #15, pages 3-4, paragraph #9.

Schwartz and Taylor disclose all the limitations of the instant claimed invention except for the support layer/substrate comprising regenerated leather material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use regenerated leather material, since it have been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. One of ordinary skill would be motivated to use regenerated leather material because it is cheaper then natural leather.

7. Claims 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwartz (3,741,844) in view of Taylor (3,971,839) for reasons of record in paper #15, pages 3-4, paragraph #9.

The method of forming the product is not germane to the issue of patentability of the of the product itself or the method of using the product. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art.

Furthermore, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In this case, the limitation directed to the method of making the composite material in claims 24-27 are methods of production and therefore does not determine the patentability of the product itself or the method of using the product.

8. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schwartz (3,741,844) in view of Taylor (3,971,839) as applied to claims 8, 9, 13, 14, 18, 19, 24-27, and 31-33 above and of record in paper #15, pages 3-4, paragraph #9, and further in view of Nishimure et al. (3,958,057).

Schwartz and Taylor disclose all the limitations of the instant claimed invention except for a dye stuff layer between the film and the leather.

Nishimure discloses a leather-like sheet comprising a pearl substrate layer, a colored layer, and a clear enameled porous sheet (col. 3, line 54 to col. 4, line 30). Where the colored

layer is a dyestuff layer (col. 4, lines 5-14). The leather-like sheet material exhibits the ability to easily perform color matching (col. 2, lines 1-9).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add a dyestuff layer as taught by Nishimure between the leather layer and the film layer. One would be motivated to do so in order enhance or change the color of the layer as desired for its intended use.

9. Claims 29 and 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwartz (3,741,844) in view of Taylor (3,971,839) as applied to claims 8, 9, 13, 14, 18, 19, 24-27, and 31-33 above and of record in paper #15, pages 3-4, paragraph #9, and further in view of Hara (JP404130172A).

Schwartz and Taylor disclose all the limitations of the instant claimed invention except for adding a leather like scent.

Hara teaches a leather coat film with a leather perfume layer (Derwent abstract).

It would have been obvious to one of ordinary skill in the art to add the leather perfume layer of Hara to the composite material of Schwartz. One would be motivated to add the leather perfume to the composite material of Schwartz in order to enhance its desirability to the consumer.

10. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schwartz (3,741,844) in view of Taylor (3,971,839) as applied to claims 8, 9, 13, 14, 18, 19, and 24-27 above and of record in paper #15, pages 3-4, paragraph #9, and further in view of GB1514224.

Schwartz and Taylor disclose all the limitations of the instant claimed invention except for a series of perforations in the composite material.

GB '224 teaches a composite material that simulates leather and may be used in virtually all areas where real leather can be used, for example, in upholstery, apparel, handbags, luggage and footwear (page 1, lines 23-27). The composite material comprising a fabric layer, a crushed foam layer, and a surface finish laminate layer (page 1, lines 28-36). A typical textile fabric to be used is cotton (page 1, lines 45-46). The surface finish laminate can be embossed (page 5, line 36) and made of polyethylene (page 5, line 22). The film can be made breathable by mechanically puncturing (perforations) the film (page 5, lines 56-58).

It would have been obvious to one of ordinary skill in the art at the time of the invention at add perforations as taught by GB '224 to the composite of Schwartz. One of ordinary skill in the art would have been motivated to add perforation to the composite of Schwartz to make Schwartz's composite breathable.

11. Claims 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Irion (2,714,571) in view of Holtzman (3,866,554) or Lockwood (3,641,603) for reasons of record in paper #15, pages 4-5, paragraph #10.

Irion and Holtzman or Lockwood disclose all the limitations of the instant claimed invention except for the support layer/substrate comprising regenerated leather material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use regenerated leather material, since it have been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. One of ordinary skill would be motivated to use regenerated leather material because it would simulate real leather better.

12. Claims 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Irion (2,714,571) in view of Holtzman (3,866,554) or Lockwood (3,641,603) for reasons of record in paper #15, pages 4-5, paragraph #10.

The method of forming the product is not germane to the issue of patentability of the of the product itself or the method of using the product. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art.

Furthermore, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In this case, the limitation directed to the method of making the composite material in claims 24-27 are methods of production and therefore does not determine the patentability of the product itself or the method of using the product.

13. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Irion (2,714,571) in view of Holtzman (3,866,554) or Lockwood (3,641,603) as applied to claims 8, 9, 13, 14, 18, 19, 24-27, and 31-33 above and of record in paper #15, pages 4-5, paragraph #10, and further in view of Nishimure et al. (3,958,057).

Irion and Holtzman or Lockwood disclose all the limitations of the instant claimed invention except for a dye stuff layer between the film and the leather.

Nishimure discloses a leather-like sheet comprising a pearl substrate layer, a colored layer, and a clear enameled porous sheet (col. 3, line 54 to col. 4, line 30). Where the colored layer is a dyestuff layer (col. 4, lines 5-14). The leather-like sheet material exhibits the ability to easily perform color matching (col. 2, lines 1-9).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add a dyestuff layer as taught by Nishimure between the leather layer and the film layer. One would be motivated to do so in order enhance or change the color of the layer as desired for its intended use.

14. Claims 29 and 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Irion (2,714,571) in view of Holtzman (3,866,554) or Lockwood (3,641,603) as applied to claims 8, 9, 13, 14, 18, 19, 24-27, and 31-33 above and of record in paper #15, pages 4-5, paragraph #10, and further in view of Hara (JP404130172A).

Irion and Holtzman or Lockwood disclose all the limitations of the instant claimed invention except for adding a leather like scent.

Hara teaches a leather coat film with a leather perfume layer (Derwent abstract).

It would have been obvious to one of ordinary skill in the art to add the leather perfume layer of Hara to the composite material of Schwartz. One would be motivated to add the leather perfume to the composite material of Schwartz in order to enhance its desirability to the consumer.

15. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Irion (2,714,571) in view of Holtzman (3,866,554) or Lockwood (3,641,603) as applied to claims 8, 9, 13, 14, 18,

19, 24-27, and 31-33 above and of record in paper #15, pages 4-5, paragraph #10, and further in view of GB1514224.

Irion and Holtzman or Lockwood disclose all the limitations of the instant claimed invention except for a series of perforations in the composite material.

GB '224 teaches a composite material that simulates leather and may be used in virtually all areas where real leather can be used, for example, in upholstery, apparel, handbags, luggage and footwear (page 1, lines 23-27). The composite material comprising a fabric layer, a crushed foam layer, and a surface finish laminate layer (page 1, lines 28-36). A typical textile fabric to be used is cotton (page 1, lines 45-46). The surface finish laminate can be embossed (page 5, line 36) and made of polyethylene (page 5, line 22). The film can be made breathable by mechanically puncturing (perforations) the film (page 5, lines 56-58).

It would have been obvious to one of ordinary skill in the art at the time of the invention at add perforations as taught by GB '224 to the composite of Schwartz. One of ordinary skill in the art would have been motivated to add perforation to the composite of Schwartz to make Schwartz's composite breathable.

ANSWERS TO APPLICANT'S ARGUMENTS

16. Applicant's arguments filed in paper #16 regarding the process of creating the composite material have been carefully considered but are moot due to the new grounds of rejections.

17. Applicant's arguments filed in paper #16 regarding the 35 U.S.C. §103 rejection over Schwartz (3,741,844) in view of Taylor (3,971,839) of record have been carefully considered but are deemed unpersuasive.

Applicant argues that there appears to be no real technical basis for Smith's extrution technology to work on leather. The Examiner disagrees with this statement in view of Schwartz's admission "methods of extrusion coating with various polymers are known and include extrusion-coating of substrates such as metal foil, plastics, foam, paper, cellophane, leather, etc.," see column 5, lines 25-28. Since Schwartz admits that he is using know extrusion-coating methods similar to that disclosed by Smith Pat. No. 3,402,086 and that it is known to extrusion-coat substrates such as leather there is real technical basis to extrusion coat leather. Therefore, it is obvious from the teachings of Schwartz that one of ordinary skill can use either foam or leather as the substrate in the composite, since it is known to extrusion coat leather as well as foam.

Applicant's argues regarding the how the process of making the invention differs from Schwartz and Smith is moot in view of the new grounds of rejection.

18. Applicant's arguments filed in paper #16 regarding the 35 U.S.C. §103 rejection over Irion (2,714,571) in view of Holtzman (3,866,554) or Lockwood (3,641,603) of record have been carefully considered but are deemed unpersuasive

Applicant argues that nobody would ever think to "spoil" a leather article by coating it with a plastic resin. The Examiner disagrees with this argument and refers Applicant patents 3,551,830 and 3,535,183 which are both directed to adding a protective layer polymeric layer to natural or synthetic leather. As stated in Irion the polyethylene layer is a well recognized protective coating material, see column 1, lines 11-12. The Examiner still maintains that one of ordinary skill would be motivated to add a layer of embossed polyethylene to a leather substrate because of the protective properties of the polyethylene to keep the leather from being damaged.

Conclusion

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Henke (4,497,871), Hodge (3,551,830), Marriot (3,535,183), and Parker (3,505,169) all disclose similar composites.

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (703) 305-1139. The Examiner can normally be reached on Monday through Thursday from 8:00 a.m. to 5:00 p.m. The Examiner can also be reached on alternate Fridays

If attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, Blaine Copenheaver can be reached by dialing (703) 308-1261. The fax phone number for the organization official non-final papers is (703) 872-9310. The fax number for after final papers is (703) 872-9311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose phone number is (703) 308-0661.

ac
2/7/02

BLAINE COPENHEAVER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700